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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,823	01/21/2004	David S. Benco	LUC-462/Benco 59-42-42-56	4074
47382	7590	02/15/2006	EXAMINER	
CARMEN B. PATTI & ASSOCIATES, LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			D AGOSTA, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/761,823	Applicant(s) BENCO ET AL.	
	Examiner Stephen M. D'Agosta	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 8-13, 15-19 is/are rejected.
7) ☒ Claim(s) 6,14 and 20 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. New prior art has been applied.

2. Applicant's arguments filed 1-17-2006 have been fully considered but they are not persuasive.

a. The examiner has read the arguments, which stretch over 8 pages, and interprets them as arguing the non-amended independent claims. Much of the arguments state that a prima facie case has not been established and that the examiner has used hindsight. The examiner disagrees. First and foremost, the applicant's claims are broadly written and thus open to broad interpretation by the examiner. The examiner has pointed out specific column and line numbers where the prior art teaches/reads on the broad claim language. The applicant states:

"For example, it is only with hindsight of Applicant's invention that the Examiner would make an assumption that the user related information such as subscription information and configuration information also refers to the phone's attributes".

The examiner disagrees since the term "attribute" can be broadly interpreted to mean virtually "anything" which would be stored in the network (eg. HLR's user profile). The applicant is invited to amend the claim such that it more specifically defines their invention and does not read on the prior art. Therefore a prima facie case has been established and no hindsight reasoning has been used.

3. After further review, the examiner now objected to claims 6, 14 and 20. Claim 7 has been cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-13 and 15-19 rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy and further in view of Kim and Staack.

As per **claims 1, 10 and 16**, McCarthy teaches a method for providing network support for an attribute feature for customization of mobile terminals by a telecommunication network (title, abstract), the method comprising the steps of:

 sending at least one attribute request from the mobile terminal to the telecommunication network (figure 3 shows step of wireless terminal requesting download from WAP portal thru to Content Provider, steps #60-61);;

 recognizing, by the telecommunication network, the attribute request from the mobile terminal (figure 3 shows steps #61-67 whereby network validates user account and item to be downloaded);

 downloading, by the telecommunication network, the requested attribute to the mobile terminal (figure 3 shows steps #67-#70 whereby item is fetched and downloaded);

 installing the attribute in the mobile terminal (figure 3, step 73 shows item being saved/stored on mobile device. Also see figures 4-6 and Para's 0003-0007 which teach downloading/storing ring tones, tactile feedback, graphic icon, animation, background, etc.); and

But is silent on

 storing in an attribute database in the telecommunication network at least one attribute for use by at least one mobile terminal;

storing in a subscriber database a data entry indicative of the mobile terminal being a subscriber of the attribute feature;

checking, upon receiving an attribute request, the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecom network;

retrieving, in response to the attribute request and in response to the mobile terminal being a subscriber of the attribute feature, the attribute from the attribute database; and

formatting future messages to the mobile terminal in a format consistent with the downloaded attribute.

McCarthy does teach checking to see if the selected item/attribute is available for download, checking to see if the user can pay and checking to see that memory is available to store the item/attribute (see figure 3). Hence one skilled would also provide a check to see what items/attributes the user already has loaded so as not to allow the user to pay for an item/attribute they already have stored on their phone. Figure 3 explicitly teaches updating the user's account (steps 70-71) which reads on updating the subscriber database.

Kim teaches a method for downloading a font to a cellular phone so that a user can easily change the existing font (abstract).

Staack teaches the HLR stores user profile/attribute information:

"...A user database 24 is provided. The user database contains user related information such as subscription information and configuration information. This can include user profiles and the home location register. In the embodiment shown in FIG. 2, the user database is shown as a single entity. ..."

(Para. 0022). The examiner interprets the user related information such as subscription information and configuration information as storing the phone's attributes as well.

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it stores in a subscriber database a data entry indicative of the mobile terminal being a subscriber of the attribute feature and checks upon

Art Unit: 2683

receiving an attribute request, the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecommunication network and future messages are consistent with the attribute download, to provide means for only allowing the user to download items/attributes they don't have stored on their phone whereby all future messages are received in the new attribute's setting(s).

With further regard to claim 16, McCarthy teaches navigating through an attribute menu on the mobile terminal and selecting from the attribute menu at least one attribute to be requested (see figure 6 which shows a user navigating through attribute menus and selecting a ring tone to download) and a recognition module, upon receiving an attribute request, checking the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecommunication network, and outputting a confirmation message when the mobile terminal is a subscriber of the attribute feature (figure 3 shows checking if account is valid, and when verified, sending the item list to the user, which reads on a confirmation message since the item list will not be sent if the user's account is not verified).

As per **claim 2**, McCarthy teaches claim 1 wherein the method further comprises the steps of:

storing the at least one attribute in an attribute database in the telecommunication network (figure 3 shows a content provider #53 which stores the attributes in a database while figure 4 furthers this concept since it shows the user being able to select multiple tones 5.1, games 5.2, images 5.3); and

retrieving, in response to the attribute request, the attribute from the attribute database (figure 3 shows the user requesting and the system fetching/sending the selected attribute).

As per **claim 3**, McCarthy teaches claim 1 wherein the method further comprises receiving future messages to the mobile terminal in a format consistent with the downloaded attribute (figure 6 shows selecting/downloading ring tones whereby the user's phone would use said downloaded ring tone for future received messages, see

Art Unit: 2683

6.3 which shows "Save and Activate" under "Tone Options") **but is silent on** receiving future messages in a format consistent with the downloaded attribute.

Kim teaches a method for downloading a font to a cellular phone so that a user can easily change the existing font (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it receives future messages in a format consistent with the downloaded attribute, to provide means to download new settings to the cell phone (eg. attribute, ring tone, game, etc.) .

As per **claims 4-5**, McCarthy teaches claim 1 wherein the attribute request/download is a request of a plurality of attributes in an attribute package (figure 4 shows the user can select from a listing of items to download, including tones, games, images, etc.. Figure 5 shows that the user can download and save an item, step #110, and then go back and request more items to download, see line from #110 to #101, which reads on the claim).

As per **claim 8**, McCarthy teaches claim 1 wherein the attribute an image (figure 4, section 5.3 shows that images can be selected) **but is silent on** one of background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode.

McCarthy does teach downloading ring tunes, games, backgrounds for games, etc.. Hence one skilled would provide for downloading colors, fonts, low/bright level modes.

Kim teaches a method for downloading a font to a cellular phone so that a user can easily change the existing font (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it is at least one of; background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode, to provide means to download new settings to the cell phone (eg. attribute, ring tone, game, etc.) .

As per **claim 9**, McCarthy teaches claim 1 wherein the method further comprises the steps of:

navigating through an attribute menu on the mobile terminal and selecting from the attribute menu at least one attribute to be requested (see figure 6 which shows a user navigating through attribute menus and selecting a ring tone to download).

As per **claims 11 and 17**, McCarthy teaches claim 10/16 wherein the attribute an image (figure 4, section 5.3 shows that images can be selected) **but is silent on** one of background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode.

McCarthy does teach downloading ring tunes, games, backgrounds for games, etc.. Hence one skilled would provide for downloading colors, fonts, low/bright level modes.

Kim teaches a method for downloading a font to a cellular phone so that a user can easily change the existing font (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it is at least one of; background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode, to provide means to download new settings to the cell phone (eg. attribute, ring tone, game, etc.) .

As per **claims 12-13 and 18-19**, McCarthy teaches claim 1/16 wherein the attribute request/download is a request of a plurality of attributes in an attribute package (figure 4 shows the user can select from a listing of items to download, including tones, games, images, etc.. Figure 5 shows that the user can download and save an item, step #110, and then go back and request more items to download, see line from #110 to #101, which reads on the claim)

As per **claim 15**, McCarthy teaches claim 10 wherein the method further comprises the steps of:

navigating through an attribute menu on the mobile terminal and selecting from the attribute menu at least one attribute to be requested (see figure 6 which shows a user navigating through attribute menus and selecting a ring tone to download).

Art Unit: 2683

Allowable Subject Matter

Claims 6, 14 and 20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims recite highly specific designs not found, either alone or in combination, in the prior art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

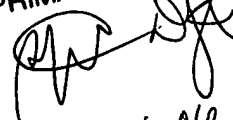
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEVE M. D'AGOSTA
PRIMARY EXAMINER



2-1-06